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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,691	05/23/2001	Hsin-Wang Wayne Chang	2537-06	2086

26797 7590 11/01/2006

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EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT PAPER NUMBER

2157

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/864,691	CHANG, HSIN-WANG WAYNE	
	Examiner	Art Unit	
	Hussein A. El-chanti	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to amendment received on June 22, 2006. Claims 1-27 are pending examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1 and 14-15 are rejected under 35 U.S.C. 101 due to lack of concreteness in operation because of the human involvement as recited in said claims. The outcome could vary due to human involvement, incapable of producing assured, repeatable results. To avoid such results, the human intervention has to be based on objective criteria. The added element recites: "...executing a negotiation process requiring human intervention to determine importance and valuation of a task and benefits to subsequently reach a bartering contract with some of the computing devices..." As written, the basis for determination is the human intervention. Nowhere in the spec that the Examiner can ascertain are there any objective criteria upon which this determination is made. If however, Applicant believes otherwise to please indicate where those objective criteria are to be found in the spec. Human intervention is only mentioned in paragraph 052 of the original spec and it states: "Automatic negotiation algorithm or negotiation algorithm with human intervention are implemented in the bartering engine for the relevant valuation parameters to reach a bartering contract."

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 14-15 are rejected under 35 U.S.C. 112, first paragraph.

Specifically, due to the added limitation "...executing a negotiation process requiring human intervention to determine importance and valuation of a task and benefits to subsequently reach a bartering contract with some of the computing devices..." the invention is incapable of producing assured, repeatable results and lacks concreteness for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. Therefore, the disclosure is not enabled. An analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the art to make and use the claimed invention. See MPEP 2164.01.

The disclosure is not enabled because the added limitation renders the claim overly broad. As stated above, the basis for determination is the human intervention. Nowhere in the spec that the Examiner can ascertain are there any objective criteria upon which this determination is made. Since there are no working examples, and no direction was provided, the quantity of experimentation required would be overwhelming. The subject matter being bartering or contract is inherently subjective, hence introducing some unpredictability into the claimed invention. Therefore, the outcome would vary according to the specific individual making the determination. The dependent claims failed to

further limit the claimed subject matter and are therefore, rejected based upon their dependency upon claims 1 and 15.

Response to Arguments

4. Applicant's arguments have been fully considered but are not persuasive.

Applicant argues in substance that the claimed "human intervention" is for a user to accept or reject sharing a computer resource and therefore Claims 1, 14 and 15 meet the statutory requirements set under 35 USC 101.

In response, (3) "CONCRETE RESULT" consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In *re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field.

The extent of the human intervention is not defined in the claim. The claim language only states "a negotiation process requiring human intervention to determine importance and valuation of a task to reach a bartering contract with some computing device". Therefore the claim language does not limit the extent of human intervention to

“accept” and “reject”. The applicant is reminded that the claims must be given their broadest reasonable interpretation.

The applicant is reminded that the claims must be given their broadest reasonable interpretation. The claim language fails to clearly the user accepting or rejecting to share a resource and if the user chooses to accept, then the computer resource will join to perform the task, however if the user rejects, then the the computing device may proceed with computing resource. The claims merely recite “a negotiation process requiring human intervention to determine importance and valuation of a task to reach a bartering contract with some computing device”.

Examiner believes that amendment to the claim to recite “the human intervention comprises the user accepting or rejecting to share a resource and if the user chooses to accept, then the computer resource will join to perform the task, however if the user rejects, then the the computing device may proceed with computing resource” would clearly define the scope of the claimed limitation and possibly overcome the 101 rejection of record.

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hussein El-chanti

Oct. 24, 2006


ARIO ETIENNE
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